

REMARKS

In this paper, claim 13 is currently amended. After entry of the above amendment, claims 1-17 are pending.

Replacement Figs. 1-11 are attached to the end of this paper. Fig. 1 has been amended to show the second shift position of second operating body (130), Fig. 2 has been amended to show the plane upon which the views shown Figs. 4 and 5 are taken, and Fig. 3 has been amended to bracket the parts shown in exploded view in order to show their relationship.

Claims 1-17 were rejected under 35 U.S.C. §112 as being indefinite.

The specification has been amended to clarify that Fig. 6 shows the first home position of first operating body (220) and that Fig. 7 shows the first shift position of first operating body (220). Additionally, Fig. 1 shows the second home position of second operating body (130) in solid lines, and Fig. 1 shows the second shift position of second operating body (130) in broken lines.

Claim 13 has been amended to properly recite the shift control device.

As for claim 7, the operating force receiving member could describe, for example, operating force receiving member (437) shown in Fig. 10. In that case, the operating force applying member could describe, for example, operating force applying member (439). Regardless of the embodiment, if two differently named elements of a claim each contain some or much common structure, but not entirely common structure, it is not double inclusion to give those elements different names as long as at least some structure is different. *See, e.g.,* Landis on Mechanics of Patent Claim Drafting, §3:9 (5<sup>th</sup> ed. 2007).

As for the use of the term “rotatable” in claim 1, it is well-settled that a structure recited in the claim may be recited as having the capability of a particular attribute. The suffix “-able” means “having capability.” In *Dorel Juvenile Group, Inc. v. Graco Children’s Products, Inc.*, 429 F.3d 1043, 77 USPQ.2d 1090 (Fed.Cir. 2005), the Court of Appeals for the Federal Circuit held that the definition of “removably attached” and “removably secured” as applied to the seat and base of a

juvenile car seat means “designed at some time or another to come apart.” Insofar as “removable” means “designed at some time or another to come apart,” the term “rotatable” in the relevant claims means “designed at some time or another to rotate.” It is the capability, not the intent at any fixed point in time, which matters. Whether or not a rotatable structure actually rotates, or whether such rotation is desirable at any particular time, is irrelevant. As noted in *Dorel*, “the claim language does not require that the seat and base come apart during normal use.” *Id.* 429 F.3d at 1045, 77 USPQ.2d at 1092.

As for the use of the word “substantially” in claims 3-5,9 and 10, words of approximation, such as “generally” and “substantially,” are descriptive terms “commonly used in patent claims ‘to avoid a strict numerical boundary to the specified parameter.’” *Ecolab, Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367, (Fed.Cir. 2001) (quoting *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217, (Fed.Cir. 1995)) As stated in *Andrew Corp. v. Gabriel Electronics Inc.*, 847 F.2d 819, 6 USPQ2d 2010,2012 (Fed.Cir. 1988): “The criticized words [including “substantially”] are ubiquitous in patent claims.” Such terms are interpreted as a matter of law by the court using the specification and drawings and do not produce indefiniteness.

Claims 1-3 and 6-17 were rejected under 35 U.S.C. §102(b) as being anticipated by Shahana (EP 1,134,158 A2). This basis for rejection is respectfully traversed.

As noted in the office action, Shahana discloses a shift control device comprising a mounting member (103) structured to mount the shift control device to a handlebar (101), wherein the mounting member defines a handlebar mounting axis (HB); a control body (170) supported by the mounting member (103) and rotatable about a rotational axis (X) for controlling a shift control cable (104); a first operating body (220); and an interface member (202) movably mounted relative to the first operating body (220). The interface member (202) pivots around a pivot axis (P) for moving the first operating body (220) from a first home position to a first shift position. However, pivot axis (P) is parallel to handlebar axis (HB) as clearly shown in Fig. 4. Thus, the pivot axis (P) is *not* inclined relative to the handlebar mounting axis (HB) as recited in claim 1.

The office action refers to paragraphs [0016] and [0017] of Shahana as teaching an inclined pivot axis (P). That is not true. Paragraph [0016] states that operating force receiving surface (203) of operating tab (202) is inclined relative to a horizontal axis (H), but that statement does not refer to pivot axis (P). Paragraph [0017] states that the path of movement of sliding operating body (220) is substantially parallel to the plane of ratchet teeth (T), but the path may vary by plus or minus thirty degrees. However, that has no effect on the orientation of pivot axis (P). There is no suggestion to vary the position of pivot axis (P).

The office action then refers to the statement at paragraph [0025] of the applicant's specification that "[w]hile operating tab 202 pivoted around a pivot axis (P) that was substantially parallel to the handlebar axis (HB) in the above embodiments, the pivot axis (P) could be inclined relative to the handlebar axis (HB) by any degree to accommodate different riding styles." That statement reflects the revelation of the present invention; it is not an admission of the teachings of the prior art.

Furthermore, it is not proper to discard the words after each occurrence of the word "wherein" in the claims. See, e.g., the *Griffin* case cited in the office action. Furthermore, Shahana does not inherently disclose an inclined pivot axis (P). To the contrary, Shahana discloses a pivot axis (P) that is parallel to the handlebar mounting axis (HB), and there is no suggestion to modify the orientation of pivot axis (P).

Claims 1-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shahana. This basis for rejection is respectfully traversed.

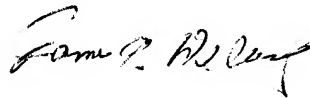
As noted above, Shahana does *not* suggest rearranging the pivot axis (P) of the tab interface (202) so that the pivot axis (P) is inclined relative to the handlebar mounting axis (HB). Paragraph [0016] of Shahana states that operating force receiving surface (203) of operating tab (202) is inclined relative to a horizontal axis (H), but that statement does not refer to pivot axis (P). Paragraph [0017] states that the path of movement of sliding operating body (220) is substantially parallel to the plane of ratchet teeth (T), but the path may vary by plus or minus thirty degrees. However, that has no effect on the orientation of pivot axis (P). There is no suggestion to vary the

position of pivot axis (P). Furthermore, as noted above, the statement at paragraph [0025] of the applicant's specification is *not* an admission of the state of the prior art. Thus, it cannot be said that the present claims are directed to the application of a known technique to a piece of prior art ready for improvement. The present claims result in a change of function wherein the gear change operation may be accomplished at least in part by a lateral swiping motion of the operating finger or thumb, whereas the Shahana device requires a vertical swiping motion of the operating finger or thumb. A change of function of a known element is a benchmark of nonobviousness. *Shackelton, et al. v. J. Kaufman Iron Works, Inc., et al.*, 217 USPQ 98 (2<sup>nd</sup> Cir. 1982)(citing *Sakraida v. Ag Pro Inc.* 425 U.S. 273, 189 USPQ 449 (1976)).

As for claims 4 and 5, the statement that Shahana's parallel axes (P) and (HB) include the angle of "substantially 90°" is repugnant to the definitions of "parallel" and "perpendicular" and cannot be maintained. The proffered interpretation is not reasonable. Also, the statement that it is common knowledge in the art to rearrange Shahana's axes (P), (HB) and (X) such that Shahana's pivot axis (P) is substantially perpendicular to the handlebar axis has no basis. No evidence was provided to show that the feature, which is recited in claim 4, is well-known.

Accordingly, it is believed that the rejections under 35 U.S.C. §102, §103 and §112 have been overcome by the foregoing amendment and remarks, and it is submitted that the claims are in condition for allowance. Reconsideration of this application as amended is respectfully requested. Allowance of all claims is earnestly solicited.

Respectfully submitted,



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